



JPW

PATENT
Customer No. 22,852
Attorney Docket No. 04853.0087

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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SAITO et al.) Group Art Unit: 1647
)
Application No.: 10/019,785) Examiner: James Jason Galvez
)
PCT Filing Date: July 6, 2000)
)
§ 371 Date: January 4, 2002)
)
For: THERAPEUTIC AGENT FOR)
DRUG-RESISTANT)
HYPERCALCEMIA)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO THE RESTRICTION REQUIREMENT

In a restriction requirement dated July 1, 2004, the Examiner required restriction under PCT Rule 13.1 between the following groups:

- Group I: claims 1-5, and 7-15, drawn to a method of alleviating drug resistant hypercalcemia using an antibody directed towards PTHrP.
- Group II: claims 1-6, and 14, drawn to a method of alleviating drug resistant hypercalcemia using an antagonist directed towards PTHrP receptor.

Applicants provisionally elect to prosecute Group I, claims 1-5, and 7-15, drawn to a method of alleviating drug resistant hypercalcemia using an antibody directed towards PTHrP, with traverse.

In making the restriction requirement, the Examiner stated that the inventions are different because "they employ different mechanisms and different chemical entities of alleviating drug resistant hypercalcemia." Office Action at 2.

Applicants respectfully disagree. The common technical feature presented in the claims of this application is the fact that the claims cover methods of inhibiting the binding between PTHrP and a receptor thereof. Section 803 of the M.P.E.P. states that "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (M.P.E.P. § 803, emphasis added.) Applicants respectfully submit that this policy should apply to this application in order to avoid unnecessary delay and duplicative examination.

Applicants submit that this search can be made without undue burden because a literature search for these groups would be largely coextensive. A thorough search for methods of inhibiting the binding between PTHrP and a receptor thereof using antibodies should also involve a search for substances such as antagonists that also inhibit the binding between PTHrP and a PTHrP receptor. Applicants respectfully submit that the claims share the same proven special technical feature and therefore request that the restriction requirement be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 29, 2004

By: Rebecca M. McNeill
for Amy E. Purcell Reg. No. 53,492 Reg. No. 43,796